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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

MCINTOSH III, TRAVISS C

ART UNIT

PAPER NUMBER

1623

DATE MAILED: 02/04/2003

6

Please find below and/or attached an Office communication concerning this application or proceeding.

File Copy

Office Action Summary

Application No.

10/054,019

Applicant(s)

BOLDI ET AL.

Examiner

Traviss C McIntosh

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 July 2002.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-50 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-50 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Election/Restrictions

- I. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-11, 32, 34, 37, 44 and 46 are drawn to a method for synthesizing the compound of Formula 7 and ultimately Formula Ia and to various compounds in the process, classified in class 536, subclass 18.7+.
 - II. Claims 12-21, 35, 38, and 47 are drawn to a method for synthesizing the compound of Formula Ib and to various compounds in the process, classified in class 536, subclass 18.7+.
 - III. Claims 22-31, 36, 39, and 48 are drawn to a method for synthesizing the compound of Formula Ic and to various compounds in the process, classified in class 536, subclass 18.7+.
 - IV. Claims 33 and 45 are drawn to a method for synthesizing the compound of Formula 7' and to various compounds of the formula 7', classified in class 536, subclass 18.7+.
 - V. Claims 40-41 are drawn to a method for the solid phase synthesis of a compound of Formula IIIa, classified in class 536, subclass 18.7+.
 - VI. Claims 42-43 are drawn to a method for the solid phase synthesis of a compound of Formula IIIb, classified in class 536, subclass 18.7+.
 - VI. Claim 49, drawn to 2 patentably distinct compounds of the general formula of Formula IIa, classified in class 536, subclass 18.7+.

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VII. Claim 50, drawn to the compound of formula IIb having the name 1-(3-benzyloxy-4,5-dihydroxy-tetrahydro-furan-2-ylmethyl)-3-phenyl-1-(4-trifluoromethoxy-benzyl)-urea, classified in class 536, subclass 53.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions I and II are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions are drawn to different compounds and to different methods of producing them.

3. Inventions I and III are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions are drawn to different compounds and to different methods of producing them.

4. Inventions I and IV are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions are drawn to different compounds and to different methods of producing them.

5. Inventions I and V are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions are drawn to different compounds and to different methods of producing them.

6. Inventions I and VI are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different

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functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions are drawn to different compounds and to different methods of producing them.

7. Inventions I and VII are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case, invention I is related to a method for synthesizing compounds of Formulas 7 and Ia and to the compounds in the process, invention VII is drawn to two distinct compounds of the general Formula IIa.

8. Inventions I and VIII are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case invention I is related to a method for synthesizing compounds of Formulas 7 and Ia and the compounds in the process, invention VIII is drawn to a specific compound, namely 1-(3-benzyloxy-4,5-dihydroxy-tetrahydro-furan-2-ylmethyl)-3-phenyl-1-(4-trifluoromethoxy-benzyl)-urea.

9. Inventions II and III are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions are drawn to different compounds and to different methods of producing them.

10. Inventions II and IV are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention IV has separate utility such as being used in the process of invention III. See MPEP § 806.05(d).

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11. Inventions II and V are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions are drawn to different compounds and to different methods of producing them.

12. Inventions II and VI are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions are drawn to different compounds and to different methods of producing them.

13. Inventions II and VII are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case invention II is related to a method for synthesizing a compound of Formula Ib and to the compounds in the process, invention VII is drawn to two distinct compounds of the general Formula IIa.

14. Inventions II and VIII are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case invention II is related to a method for synthesizing a compound of Formula Ib and the compounds in the process, invention VIII is drawn to a specific compound, namely 1-(3-benzyloxy-4,5-dihydroxy-tetrahydro-furan-2-ylmethyl)-3-phenyl-1-(4-trifluoromethoxy-benzyl)-urea.

15. Inventions III and IV are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be

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separately usable. In the instant case, invention IV has separate utility such as being used in the process of invention II. See MPEP § 806.05(d).

16. Inventions III and V are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions are drawn to different compounds and to different methods of producing them.

17. Inventions III and VI are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions are drawn to different compounds and to different methods of producing them.

18. Inventions III and VII are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case invention III is related to a method for synthesizing a compound of Formula Ic and to the compounds in the process, invention VII is drawn to two distinct compounds of the general Formula IIa.

19. Inventions III and VIII are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case invention III is related to a method for synthesizing a compound of Formula Ic and the compounds in the process, invention VIII is drawn to a specific compound, namely 1-(3-benzyloxy-4,5-dihydroxy-tetrahydro-furan-2-ylmethyl)-3-phenyl-1-(4-trifluoromethoxy-benzyl)-urea.

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20. Inventions IV and V are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions are drawn to different compounds and to different methods of producing them.

21. Inventions IV and VI are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions are drawn to different compounds and to different methods of producing them.

22. Inventions IV and VII are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case invention IV is related to a method for synthesizing a compound of Formula 7' and to the compounds of the formula 7', invention VII is drawn to two distinct compounds of the general Formula IIa.

23. Inventions IV and VIII are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case invention IV is related to a method for synthesizing a compound of Formula 7' and to the compounds of the formula 7', invention VIII is drawn to a specific compound, namely 1-(3-benzyloxy-4,5-dihydroxy-tetrahydro-furan-2-ylmethyl)-3-phenyl-1-(4-trifluoromethoxy-benzyl)-urea.

24. Inventions V and VI are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different

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functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case invention V is drawn to solid phase synthesis of compounds of formula IIIa and invention VI is drawn to solid phase synthesis of compounds of formula IIIb.

25. Inventions V and VII are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case invention V is drawn to solid phase synthesis of compounds of formula IIIa and invention VII is drawn to compounds of the Formula IIa.

26. Inventions V and VIII are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case invention V is drawn to solid phase synthesis of compounds of formula IIIa and invention VIII is drawn to a specific compound, namely 1-(3-benzyloxy-4,5-dihydroxy-tetrahydro-furan-2-ylmethyl)-3-phenyl-1-(4-trifluoromethoxy-benzyl)-urea.

27. Inventions VI and VII are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case invention VI is drawn to solid phase synthesis of compounds of formula IIIB and invention VII is drawn to compounds of the Formula IIa.

28. Inventions VI and VIII are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case

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invention VI is drawn to solid phase synthesis of compounds of formula IIIb and invention VIII is drawn to a specific compound, namely 1-(3-benzyloxy-4,5-dihydroxy-tetrahydro-furan-2-ylmethyl)-3-phenyl-1-(4-trifluoromethoxy-benzyl)-urea.

29. Inventions VII and VIII are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case invention VII is drawn to compounds of the Formula IIa and invention VIII is drawn to a specific compound, namely 1-(3-benzyloxy-4,5-dihydroxy-tetrahydro-furan-2-ylmethyl)-3-phenyl-1-(4-trifluoromethoxy-benzyl)-urea.

30. Because these inventions are distinct for the reasons given above and the search required for one Group is not required for the other Groups, restriction for examination purposes as indicated is proper.

31. Claims 44-50 are generic to a plurality of disclosed patentably distinct species comprising multiple structurally divergent compounds. Applicant is required under 35 U.S.C. 121 to elect a single disclosed species, even though this requirement is traversed.

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the

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examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

32. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

33. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

34. It is noted that applicant is entitled to elect one method and one compound in the instant application. Only one compound and one method of making will be examined in the instant application, 10/054,019. Applicant is not entitled to the search of multiple methods and multiple compounds.

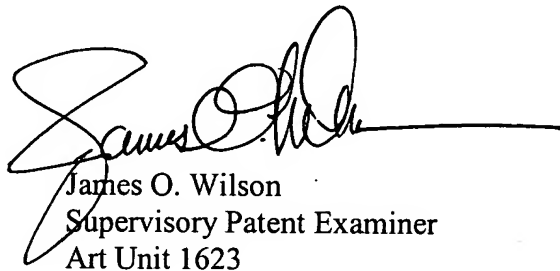
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Traviss C McIntosh whose telephone number is 703-308-9479. The examiner can normally be reached on M-F 8:30-5:00.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James O. Wilson can be reached on 703-308-4624. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-3014 for regular communications and 703-305-3014 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0196.

Traviss C. McIntosh
January 31, 2003



James O. Wilson
Supervisory Patent Examiner
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